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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/673,143 | 09/30/2003 | Young-Woo Lee | 1293.1829 | 3823 |

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| EXAMINER |
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PSITOS, ARISTOTELIS M

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| ART UNIT | PAPER NUMBER |
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2627

DATE MAILED: 07/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

| | | |
|-----------------------------------|----------------------------|--|
| Application No. 10/673,143 | Applicant(s) LEE ET AL. | |
| Examiner Aristotelis M. Psitos | Art Unit 2627 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 9-14, 22-26 and 34-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 15-21 and 27-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Applicants' response of 6/13/06 has been considered with the following results.

Claims 9-14,22-26, and 34-38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 6/13/06.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The IDS documents filed on 6/13/05 and 9/30/03 have been made of record.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

1. Claims 7, 8, 20, 21 and 32 and 33 are rejected under either 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement, or alternatively under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims attempt to define the amplitude of the predetermined value. As disclosed this is a range of between 14-18 nm. Hence the range disclosed and the values claims are not the same.

Under paragraph 1, the claimed value finds no clear support/enablement, and under paragraph 2 the claimed value(s) are indefinite. Appropriate correction is respectfully required.

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Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 34-38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims attempt to recite a data structure, however, such not claimed in a computer readable medium are descriptive material per se, see Warmerdam, 33F.3d at 1361.

Also, applicants are attempting to define functionally descriptive material, however, as disclosed there is no computer. What is disclosed is an optical recording/reproducing system – i.e., this is NOT A COMPUTER. Therefore, the claims are not drawn to the disclosed invention.

As far as the claims recite positive limitations, the following rejections are made.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 15, 18 and 27, 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshida et al.

The following analysis is made:

Claim 1

Yoshida et al

A recording medium type discriminating apparatus,
comprising:

abstract/title

see figs. 1 & 2

a radio frequency (RF) amplifier to output
a signal based on light reflected from a
recording medium;

description thereof

a wobble amplitude detector to detect an
amplitude of a wobble formed on the recording

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medium based on an output signal of the RF amplifier; and

a system controller to discriminate a recording medium type
of the recording medium by
comparing the wobble amplitude with a reference value.

As analyzed above the above system discriminates medium type by having the appropriate RF output signal detected, a wobble signal detector ability and appropriate comparison.

The method limitations of claim 15 are met when the above system operates.

With respect to claim 34, the record medium provided is interpreted to have computer readable code thereon.

With respect to claim 2, as disclosed such is present – push-pull wobble detector.

With respect to claims 3,4 and 18 and 30 such is present – see discussion with respect to figure 2.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly

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owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 5-8,16-17, 19-21,28,29,31-33 rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1-4,15,18,27,30 as stated in paragraph 3 above, and further in view of Morita.

With respect to the amplitude value regarding dvd-rw, such is further disclosed in Morita – see for instance col. 14, lines 34 plus.

With respect to dvd+rw, such is of course an agreed upon range (once noting the amplitude range for the dvd-rw discussed in Morita.

It would have been obvious to modify the base system of Yoshida et al with the above teaching from Morita in order to set an appropriate threshold value, or range of values that are indicative of the breaking point between the dvd-rw and dvd+rw amplitude. Selection of such is an optimization of the system and obvious predicated upon the well-known dvd-rw amplitude range.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kim, Pietruszynski et al, Endoh et al and Yoshida et al ('726) prior art discrimination capabilities/abilities predicated upon wobble amplitude evaluation/criteria.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M. Psitos whose telephone number is (571) 272-7594. The examiner can normally be reached on M-F: 6:00 - 2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne D. Bost can be reached on (571) 272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aristotelis M Psitos
Primary Examiner
Art Unit 2627

A handwritten signature in black ink, appearing to be 'APsitos', with a long, sweeping underline that extends downwards and to the left.

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